

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 1-5 are pending in the application. Claims 2 and 4 have been amended to address formal matters. Support for the changes may be found generally throughout the specification and in the original claims.

Claims 1-5 were rejected under 35 USC §112, second paragraph, for allegedly being indefinite. Applicants believe the present amendment overcomes this rejection.

Claim 2 has been amended to recite that both of the pair of adjacent groups R1 and R2 and the pair of adjacent groups R3 and R4 represent a pair of benzyl groups. Accordingly, it is believed that claim 2 now further limits the subject matter of claim 1.

Claim 4 has been amended to delete the recitation to "being adapted to be used in an optical recording layer". Rather, claim 4 now recites that the optical recording material is formed on a substrate to make an optical recording medium.

In view of the above, applicants respectfully request that the rejection be withdrawn.

Claims 1 and 3-5 were rejected under 35 USC §103(a) as allegedly being unpatentable over YANO JP 2003-231359. Claims 1-5 were rejected under 35 USC §103(a) as allegedly being

unpatentable over YANO et al. JP 2003-335061. Claims 1-5 were also rejected under 35 USC §103(a) as allegedly being unpatentable over YANO et al. JP 2003-335061, in combination with JPO abstract of JP 03-224793 and SAKAI et al. These rejections are respectfully traversed.

The YANO et al. JP 2003-231359 publication and YANO et al. JP 2003-335061 publication were filed on August 19, 2003 and November 25, 2003, respectively. Each of these dates is later than the priority date of the present application of August 7, 2003. Accordingly, applicants file herewith the verified translation for Japanese Patent Application No. 2003-289166, filed on August 7, 2003.

In view of the above, both YANO publications fail to qualify as prior art. Applicants request that the rejections be withdrawn.

Claims 1-5 were rejected under 35 USC §103(a) as allegedly being unpatentable over any one of TOMINAGA et al. JP 2000-108510, HAMADA et al. or TOMINAGA et al. JP 2000-289335 in view of NAGATAKI et al., the JPO abstract of JP 03-224793 and SAKAI et al. This rejection is respectfully traversed.

None of the cited references teach a compound represented by the formula (1) of the claimed invention, wherein R1 and R2 or R3 and R4 each represent a pair of benzyl groups. Additionally, there is no recognition of a compound represented by the formula (1) of the present invention, wherein all of R1 to

R4 represent benzyl groups.

The claimed compound exhibits unexpected and advantageous properties when R1 and R2, R3 and R4, or all of R1 to R4 represent benzyl groups. For example, the claimed compound exhibits a low decomposition temperature and a proper absorption wavelength. This is believed to be supported by and apparent from reviewing the comparative results set forth in the present specification (e.g., see comparative compounds 1-3 of Table 1).

In imposing the rejection, the Official Action acknowledges that dye 3 of TOMINAGA et al JP 2000-108510, dye 7 or 10 of HAMADA et al JP 2000-168233, or dye 3 of TOMINAGA et al 2000-289335 do not disclose or suggest the claimed invention.

Rather, in an effort to remedy the deficiencies of TOMINAGA et al. JP 2000-108510, HAMADA et al. or TOMINAGA et al. JP 2000-289335 for reference purposes, the Official Action cites to NAGATAKI et al., the JPO abstract of JP 03-224793 and SAKAI et al.

Although NAGATAKI et al. JP 10-278426 teaches a compound represented by the formula (I) of the present invention, wherein R1 to R4 are aralkyl groups, it does not disclose that R1 to R4 may be benzyl groups. Indeed, NAGATAKI et al. even teaches that it is preferable that the groups R1 to R4 are either a methyl group or an ethyl group (see [0011] of NAGATAKI). In this regards, it is believed that NAGATAKI et al leads one skilled in the art away from the claimed invention.

As to JP 03-224793, the machine translation of JP 03-224793 generated by the JPO contains several errors. In particular, JP 03-224793 does not teach or suggest that R1 to R3 are benzyl groups. Rather, it is disclosed that R1 to R3 groups may be C₁₋₈ alkyl groups. Thus, it can not be said that one skilled in the art would have been motivated to combine and modified the teachings of the JP 03-224793 publication with the teachings of any of the other publications to obtain the claimed invention.

The compound of SAKAI et al. JP 58-021746 is a hydrazone compound, not a cyanine compound. Thus, one skilled in the art would have lacked the motivation to combine and modify any of the attributes or properties of the compounds of TOMINAGA et al. JP 2000-108510, HAMADA et al. or TOMINAGA et al. JP 2000-289335 with that of SAKAI et al.

In view of the above, one skilled in the art would not have been motivated to combine and modify the teachings of TOMINAGA et al. JP 2000-108510, HAMADA et al. or TOMINAGA et al. JP 2000-289335 with the compounds of NAGATAKI et al., the JPO abstract of JP 03-224793, or SAKAI et al.

However, the Official Action contends that it would have been obvious to modify the above-identified dyes by forming the benzyl analogs where two benzyl moieties are bound to the carbon of the indole ring in place an alkyl moiety to form the claimed dyes and to use these in optical recording media with a

reasonable expectation of realizing the benefits ascribed to these dyes by TOMINAGA et al. JP 2000-108510, HAMADA et al. or TOMINAGA et al. JP 2000-289335 based upon the use of aralkyl moieties in both locations by NAGATAKI et al., the use of benzyl groups in the JPO abstract of JP 03-224793, or the use of indoleneic dyes of SAKAI et al. which bear paired benzyl moieties.

However, there is no evidence of record that supports the allegation it would have been obvious to modify the dyes of TOMINAGA et al. JP 2000-108510, HAMADA et al. or TOMINAGA et al. JP 2000-289335 by forming the benzyl analogs where two benzyl moieties are bound to the carbon of the indole ring in place an alkyl moiety to form the claimed dyes.

Furthermore, none of the publications of the cited publications support the allegation that one skilled in the art would have turned to the use of aralkyl moieties in both locations by NAGATAKI et al., the use of benzyl groups in the JPO abstract of JP 03-224793, or the use of indoleneic dyes of SAKAI et al. which bear paired benzyl moieties.

In view of these unsupported allegations, the Examiner is reminded that a critical step in analyzing obviousness pursuant to 35 U.S.C. §103(a) is casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, only guided by the publications and then-accepted wisdom in the field. Close adherence to this

methodology is important in cases where the invention itself may prompt an Examiner to "fall victim to the insidious effect of a hindsight syndrome, wherein that which only the invention taught is used against its teacher." Indeed, to establish a prima facie case of obviousness, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ 2d 1313, 1362 (Fed. Circ. 2000). The fact that the prior art could be so modified would not have made the modification itself obvious unless the cited publications themselves suggested the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Circ. 1984).

In light of the lack of a motivation, suggestion or teaching of the desirability of making the claimed combination, applicant believes that the publication fails to disclose or suggest the claimed invention.

Accordingly, it is believed that each of the proposed combinations of publications fail to disclose or suggest the claimed invention.

Claims 1 and 3-5 were provisionally rejected on the grounds of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-24 of co-pending Application No. 10/973,444. Claims 1-5 were provisionally rejected on the grounds of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-5 of co-

pending Application No. 10/899,027. These rejections are respectfully traversed.

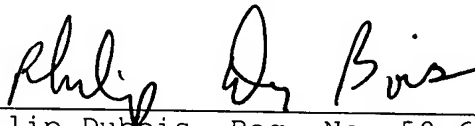
Applicants attach to the present amendment a terminal disclaimer to obviate the double patenting rejections.

In view of the present amendment and foregoing remarks, therefore, applicants believe the present application is in condition for allowance at the time of the next Official Action. Allowance and passage to issue on that basis is respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

The Appendix includes the following items:

- terminal disclaimer
- a verified English translation of foreign priority document